

Remarks

The Office Action dated June 7, 2006 has been reviewed, and the following remarks are made in response thereto. In view of the following remarks, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims. Upon entry of the instant amendment, claims 1-6, 9-14, 16, 24-27, 36-43 and 45-56 are pending. Claims 7, 8 and 44 are cancelled without prejudice or disclaimer to the subject matter claimed therein. Claims 1, 4, 9, 41 and 52-54 are amended. Although claims 52-56 are withdrawn from examination, we have amended claims 52-54 to include the limitation of claim 47, respectively, in the event that claims 52-56 will be rejoined, once claim 47 is found to be allowable. Written support for the claim amendments is found throughout the specification and in the original claims, thus Applicants submit that no prohibited new matter has been added.

Summary of the Final Office Action

1. Claims 52-56 were withdrawn from consideration as being drawn towards a nonelected invention.
2. Claim 44 was objected to as being of improper dependent form for failing to limit the subject matter of a previous claim.
3. Claims 1, 2, 7-9, 24, 25 and 38 were rejected under 35 U.S.C. 112 (first paragraph) for failing to comply with the written description requirement.
4. Claims 3-6, 10-14, 16, 26, 27, 36, 37, 39-43 and 45-51 were deemed allowable.

Objection to the Claims

Claim 44 was objected to as being of improper dependent form for failing to limit the subject matter of a previous claim. Specifically, the Examiner alleged that claim 44 contains the recitation that the primer or probe of interest “specifically hybridizes to a viral nucleic acid” while claim 43, from which it depends, also states that the primer or probe “specifically hybridizes to one of the designated viral nucleic acids.

Without acquiescing to the merits of the Examiner’s objection, and solely to expedite prosecution of the instant application, Applicants have cancelled claim 44, thereby rendering this rejection moot.

Rejections under 35 U.S.C. 112 (first paragraph)

Claims 1, 2, 7-9, 24, 25 and 38 were rejected under 35 U.S.C. 112 (first paragraph) for failing to comply with the written description requirement. In particular, the Examiner alleged that the specification did not provide adequate support for the claimed genus of “variant erythroviruses” as set forth in species (ii) of claim 1.

Without acquiescing to the merits of the Examiner's objection, and solely to expedite prosecution of the instant application, Applicants have removed species (ii) from claim 1, thereby rendering the rejection moot as to species (ii). Moreover, Applicants have cancelled claims 7 and 8, thereby rendering the rejection moot with respect to these claims.

Additionally, the Examiner alleged that the specification did not adequately describe nucleic acids that hybridize under stringent conditions to the full-length V9 sequence of SEQ ID NO: 1 or to fragments and primers thereof (species (iii) and (iv) of claim 1) because the disclosure fails to identify those portions of the viral genome that can tolerate nucleotide sequence additions, deletions, or substitutions and still retain the characteristics of a V9 variant. Applicants respectfully traverse this rejection.

Applicants respectfully point out that Example 9 of the *Revised Interim Written Description Guidelines Training Materials* (1999) discloses a claim with hybridization language. The claim was found to be adequately described even though the specification only disclosed a single species, SEQ ID NO: 1. The reason is that the claim sets forth the hybridization conditions and one of skill in the art would not expect substantial variation among species encompassed within the scope of the claims. Likewise, claim 1 of the present application includes the limitation that the nucleic acid molecules must hybridize under stringent conditions to the complement of a nucleic acid molecule encoding SEQ ID NO: 1 or fragments thereof, thereby limiting variation among the nucleic acid molecules encompassed within the scope of the claims. The Office Action also cites *University of California v. Eli Lilly* and *Amgen v. Chugai* to support their rejection. Applicants respectfully point out that the cited cases are not applicable because the claims do not encompass a broad genus of viral nucleic acids. Unlike the claims in the cited cases which encompass either a broad genus of nucleic acids (*Lilly*) or a broad genus of proteins, the claims of the present application only encompass nucleic acids that hybridize under stringent conditions to SEQ ID NO: 1.

Accordingly, Applicants respectfully request that the rejection of claims 1, 2, 9, 24, 25 and 38 for failing to comply with the written description requirement be reconsidered and withdrawn.

Conclusion

Applicants respectfully request that the above remarks be made of record in the file history of the present application. It is respectfully submitted that all claims are now in condition for allowance, early notice of which would be appreciated. Should the Examiner disagree, Applicants respectfully request a telephonic or in-person interview with the undersigned attorney to discuss any remaining issues and to expedite the eventual allowance of the claims.

Except for issues payable under 37 C.F.R. 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **constructive petition for extension of time** in accordance with 37 C.F.R. 1.136(a)(3).

Dated: **November 7, 2006**
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Respectfully submitted,
Morgan, Lewis & Bockius LLP

A handwritten signature in black ink, reading "Christopher J. Betti". The signature is written in a cursive, flowing style. The first name "Christopher" is written in a larger, more prominent script, while "J. Betti" follows in a similar but slightly smaller script. The signature is positioned above a horizontal line.

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